

Docket No.: 00-8018 RCE1

REMARKS**Introduction**

As a preliminary matter, Applicant thanks the Examiner for his careful examination of this application and for the indication of allowable subject matter contained in the Office Action. In the Office Action: (1) claim 18 was allowed; (2) claim 5 was objected to as being dependent upon a rejected base claim but indicated to be allowable if rewritten in independent form; (3) claims 1-4 and 11-12 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Publication No. 2001/0054087 to Flom et al. (hereinafter "Flom"); (4) claims 6-10 and 14-17 were rejected under 35 U.S.C. §103(a) as being obvious over Flom in view of U.S. Publication No. 2002/0052824 to Mahanti et al. (hereinafter "Mahanti"); and (5) claim 13 was rejected under 35 U.S.C. §103(a) as being obvious over Flom in view of U.S. Patent No. 5,978,828 to Greer et al. (hereinafter "Greer").

Applicant has amended independent claims 1 and 11. Claims 5, 12, and 13 have been canceled. Thus, claims 1-4, 6-11, and 14-18 are presently pending in this application. No new matter has been introduced. Applicant respectfully submits that the presently pending claims are in condition for allowance for the reasons discussed below.

Objection to Claim 5

On page 3 of the Office Action, the Examiner objected to claim 5 as being dependent upon a rejected base claim. The Examiner further indicated that claim 5 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant has accordingly amended independent claim 1 to include the substantive limitations of claim 5, and claim 5 has been canceled.

Independent Claim 1

The Examiner rejected independent claim 1 under 35 U.S.C. §102(e) as being anticipated by Flom (Office Action, page 4). As mentioned above, Applicant has amended independent claim 1 to include the substantive limitations of claim 5. The limitation of the mobile cache being disposed between the wireless network and the Internet has been deleted from the claim. Based on the Examiner's indication of allowable subject matter contained in

Docket No.: 00-8018 RCE1

claim 5 (page 3), Applicant respectfully requests that the Examiner withdraw the rejection of claim 1, and it is submitted that amended claim 1 and its dependent claims (claims 2-4 and 6-10) are in condition for allowance.

Independent Claim 11

The Examiner rejected independent claim 11 under 35 U.S.C. §102(e) as being anticipated by Flom (page 4). Applicant has amended independent claim 11. The amendments to claim 11 include the substantive limitations of claims 12 and 13, as well as language intended to further articulate that the steps of monitoring and triggering are executed at the mobile cache. Claims 12 and 13 have been canceled.

In the Office Action, the Examiner rejected claim 12 under 35 U.S.C. §102(e) as being anticipated by Flom, while claim 13 was rejected under 35 U.S.C. §103(a) as being obvious over Flom in view of Greer. Therefore, Applicant's arguments are directed to the patentability of amended claim 11 over the Examiner's asserted combination of Flom and Greer. Applicant respectfully submits that amended claim 11 is in condition for allowance because neither Flom, Greer, nor any reasonable combination of Flom and Greer teach the amended claim limitations of:

monitoring, at the mobile cache, a number of information changes in the object database; and
triggering the delivery step once the number of information changes in the object database at the mobile cache reaches a predetermined threshold.
(Emphasis added.)

On page 11 of the Office Action, the Examiner asserts that Flom teaches a web page control database for determining a number of web page content changes. However, the Examiner fails to provide a specific reference to support this assertion. In fact, Flom contains no such teaching. The closest Flom comes to any such teaching is in automatically notifying a user of a new or newly reviewed restaurant in a geographic area that matches geo-specific search criteria input by the user (paragraph 59 of Flom). Simply apprising a user of a new restaurant based on the user's matching geographic preferences in no way teaches the claim limitation of monitoring, at the mobile cache, a number of information changes in the object database. Greer also fails to teach monitoring, at a mobile cache, a number of information

Docket No.: 00-8018 RCE1

changes in the object database. Because the cited references do not teach the claim limitation of monitoring, at a mobile cache, a number of information changes in the object database, the Examiner has failed to establish a *prima facie* case of obviousness against this claim limitation. See *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); MPEP §2143.03.

With respect to the claim limitation of triggering the delivery step once the number of information changes in the object database at the mobile cache reaches a predetermined threshold, the Examiner admits that Flom does not teach this limitation. The Examiner then asserts that Greer teaches this limitation. Applicant respectfully disagrees because Greer is limited to a client polling a host server for changes made to web pages at the host server and does not in any way teach changes in an object database at a mobile cache reaching a predetermined threshold (col. 3, lines 33-43; col. 8, lines 30-67). In Greer, a web page author associates a web page control database *located at the host server* with the creation and editing of the web page and assigns values to the database for changes made to the web page (col. 4, lines 55-65). Thus, Greer does not teach the claim limitation of triggering the delivery step once the number of information changes in the object database at the mobile cache reaches a predetermined threshold, and the Examiner has therefore failed to establish a *prima facie* case of obviousness against this claim limitation.

Because neither Flom nor Greer teaches the claim limitations of monitoring and triggering as recited in amended claim 11, Applicant respectfully requests that the Examiner withdraw the rejection of independent claim 11, and it is submitted that claim 11 and its dependent claims (claims 14-17) are in condition for allowance.

Dependent Claims

The dependent claims (claims 2-4, 6-10, and 14-17) are in condition for allowance as depending from amended independent claims 1 and 11. Nevertheless, the dependent claims independently recite patentable subject matter. Merely by way of example, Applicant submits that the Examiner has not established a *prima facie* case of obviousness against claims 6-10 and 14-17 because the cited references fail to teach every limitation recited in these claims. Moreover, there is no motivation to combine or modify the references to read on these claims (MPEP 2143.03). Accordingly, for at least the reasons presented below, Applicant

Docket No.: 00-8018 RCE1

respectfully requests that the rejections of claims 6-10 and 14-17 under §103(a) be withdrawn.

A. There is no motivation to combine or modify the cited references to read on claims 6-10 and 14-17.

In the Office Action, the Examiner rejected claims 6-10 and 14-17 under 35 U.S.C. § 103(a) as being obvious over Flom in view of Mahanti (page 8). The Examiner admits that Flom does not disclose converting an image format and caching the converted image (page 8). On page 9 of the Office Action, the Examiner asserts that given Mahanti's teaching of image format conversion, a person of ordinary skill in the art would have recognized the desirability of modifying Flom with the system of Mahanti. However, there would have been no motivation to modify Flom based on Mahanti because Mahanti is unrelated to wireless applications. The system of Mahanti is directed to automated negotiation processing and does not appear to include any teaching related to caching associated with a wireless device (see Abstract of Mahanti). Thus, one of ordinary skill in the art would not have been motivated to modify Flom as suggested by the Examiner. Therefore, Applicant respectfully requests that the Examiner withdraw this rejection because the Examiner has not established a *prima facie* case of obviousness against claims 6-10 and 14-17, which are believed to be in condition for allowance.

B. The cited references do not teach extracting data segments of the selected data based on the output preference data as recited in claims 7, 9, and 16.

On page 9 of the Office Action, the Examiner asserts that paragraphs 41-43 of Mahanti disclose extracting data segments. The Examiner also asserts that Flom discloses "based on the output preference data," according to his rejection of claim 1 (pages 9-10). However, the Examiner's rejection of claim 1 does not cite any teaching in Flom of extracting data segments based on output preference data. The Examiner's discussions of output preference data in the rejections of claim 1 are related to dynamically composing user-specific output data and do not mention any functionality of extracting data segments. Further, Flom contains no teaching of extracting data segments, much less extracting data segments of the selected data based on the output preference data.

Docket No.: 00-8018 RCE1

Similarly, Mahanti does not teach extracting data segments based on the output preference data. In particular, there is no teaching of output preference data in the paragraphs (paragraphs 41-43) cited by the Examiner.

Although the Examiner points out at pages 9-10 of the Office Action that the rejections of claims 7, 9, and 16 are based on combinations of references, the cited references fail to teach each claim's limitations as a whole. Even if one of ordinary skill were somehow motivated to combine the references, the combined references do not teach extracting data segments based on the output preference data. Therefore, Applicant respectfully requests that the Examiner withdraw the rejections of claim 7, 9, and 16 because the Examiner has not established a *prima facie* case of obviousness against these claims, which are believed to be in condition for allowance.

Docket No.: 00-8018 RCE1

CONCLUSION

All objections and rejections have been addressed. In view of the above, the presently pending claims are believed to be in condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue. It is believed that any fees associated with the filing of this paper are identified in an accompanying transmittal. However, if any additional fees are required, they may be charged to Deposit Account 07-2347. To the extent necessary, a petition for extension of time under 37 C.F.R. 1.136(a) is hereby made, the fee for which should be charged against the aforementioned account.

Respectfully submitted,

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